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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,997	03/15/2001	Jeffrey R. Mount	201940US25	3744

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,997

Applicant(s)

MOUNT ET AL

Examiner

John L Young

Art Unit

3622

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

John Leonard Young, Esq.
JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 & 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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2. Claims 1-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schultz et al. 5,056,019 (10/8/1991) (herein referred to as "Schultz") in view of Burton et al. 5,025,372 (6/18/1991) (herein referred to as "Burton") and further in view of Small 4,815,741 (03/28/1989) (herein referred to as "Small").

As per claim 1, Schultz (col. 4, ll. 15-30) discloses: *"Another coupon distribution technique utilizing a computer system. . . . Recognizing that a manufacturer desires to distribute coupons to consumers who purchase a competitor's products . . . teaches a system for generating a machine-readable coupon for a product when the bar-code of a competitive product is read by the check-out terminal scanner. Hence, the manufacturer is able to distribute a coupon directly to the consumer it is targeting, a customer of the competition."* In this case, the Examiner interprets this disclosure as suggesting "converting values of unrelated coupons to points. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50) shows elements that suggest "point issue means for issuing the points to the customer according to transactions performed by the customer. . . ."

Schultz (col. 6, ll. 6-10; col. 4, ll. 56-60; col. 5, ll. 15-20; col. 8, ll. 40-55; col. 8, ll. 64-65; col. 10, ll. 20-27; and col. 10, ll. 46-50) shows elements that suggest "point notification means for notifying the customer of point information comprising the issued points. . . ."

Schultz (col. 7, ll. 25-27) discloses *"accumulating sales data. . . ."*

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Schultz (col. 10, ll. 7-15; col. 10, ll. 20-27; col. 10, ll. 36-39; col. 10, ll. 46-50; col. 9, ll. 25-33; col. 8, ll. 48-65; col. 7, ll. 35-44; col. 8, ll. 1-6; and col. 5, ll. 45-53) shows

elements that suggest "point accumulation means for calculating and accumulating the issued points of a current transaction and issued point of a previous transaction. . . ."

Schultz (col. 6, ll. 28-36; col. 6, ll. 39-52; col. 7, ll. 5-10; and col. 10, ll. 1-13) shows elements that suggest "customer identification means for identifying the customer according to customer identification information. . . ."

Schultz (col. 8, ll. 30-63) discloses "*customer service support. . . .*" and elements that suggest "types of services. . . ."

Schultz (col. 5, ll. 57-60) discloses: "*The purchase reward offers . . . can include standard rebates, trial rebates, gift offers, and sweepstakes offers. . . .*"

Schultz (col. 5, ll. 57-60) discloses: "*Once the purchase reward offers . . . are defined by the manufacturer . . . the central management firm . . . stores records of the purchase reward offers . . . in an offer file . . . residing in the data bank of the PMCS [program management computer system] The products that are the subject of the purchase reward offers . . . have associated Universal Product Codes (UPC), which are used to access the reward offer records in the offer file. . . . In the instance when a reward offer applies to several products, the UPC of each eligible product for the reward offer will access to the reward offer record to which the products apply. . . .*" The examiner interprets this disclosure as suggesting "wherein the point notification means

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includes service contents storage means for storing a list of types of services and corresponding points. . . ."

Schultz (col. 6, ll. 5-12; and col. 7, ll. 60-68) discloses "the manufacturer can offer an entry into a sweepstakes drawing for each product purchase. . . ." The examiner interprets this disclosure as suggesting "wherein the point notification means includes service contents storage means for storing a list of types of services and corresponding points. . . ."

Schultz (col. 9, ll. 30-38; col. 9, ll. 47- 59; col. 10, ll. 7-35; col. 7, ll. 5-10; col. 7, ll. 20-59; col. 9, ll. 1-2; and col. 9, 60-65) shows elements that suggest "notification means . . . reads data out of the storage means according to a type selected by the customer through a terminal, and notifies the customer of the read data."

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) shows the elements and limitations of claim 1.

Schultz does not explicitly show "converting values of unrelated coupons to points. . . ." even though Schultz (col. 4, ll. 15-30) suggests same.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the disclosure of Schultz cited above would have been selected would have been selected in accordance with "converting values of unrelated coupons to points. . . ." because selection of such features would have provided means for

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“rewarding specific purchase behavior and increasing consumer brand loyalty for manufacturers. . . .” (See Schultz (col. 4, ll. 50-55)).

As per claims 2-10, Schultz shows the method of claim 1 and subsequent claims depending from claim 1.

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) suggests the elements and limitations of claims 2-10.

Schultz lacks an explicit recitation of the elements and limitations of claims 2-10 even though Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-10 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-10, because selection/modification of the disclosure of Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) would have provided means for *“rewarding*

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specific purchase behavior and increasing consumer brand loyalty for manufacturers. . . ." (See Schultz (col. 4, ll. 50-55)).

Independent claim 11 is rejected for substantially the same reasons as independent claim 1.

As per claims 12-18, Schultz shows the system of claim 11 and subsequent claims depending from claim 11.

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) suggests the elements and limitations of claims 12-18.

Schultz lacks an explicit recitation of the elements and limitations of claims 12-18 even though Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 12-18 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 12-18, because selection/modification of the disclosure of Schultz (the ABSTRACT; FIG. 1; FIG. 2; col.

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1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) would have provided means for “*rewarding specific purchase behavior and increasing consumer brand loyalty for manufacturers. . . .*” (See Schultz (col. 4, ll. 50-55)).

Independent claim 19 is rejected for substantially the same reasons as independent claim 1.

As per claims 20-26, Schultz shows the system of claim 19 and subsequent claims depending from claim 19.

Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) suggests the elements and limitations of claims 20-26.

Schultz lacks an explicit recitation of the elements and limitations of claims 20-26 even though Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 20-26 were well known and expected in the art at the time of the

invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 20-26, because selection/modification of the disclosure of Schultz (the ABSTRACT; FIG. 1; FIG. 2; col. 1, ll. 6-11; col. 1, ll. 15-16; col. 6, ll. 5-10; col. 5, ll. 12-15; col. 4, ll. 56-60; col. 5, ll. 47-53; col. 5, ll. 57-68; col. 6, ll. 1-4; col. 6, ll. 10-12; col. 8, ll. 45-55; col. 8, ll. 64-65; and col. 10, ll. 46-50 and the whole document) would have provided means for *“rewarding specific purchase behavior and increasing consumer brand loyalty for manufacturers. . . .”* (See Schultz (col. 4, ll. 50-55)).

CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or (703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

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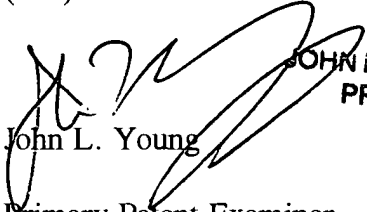
Hand delivered responses may be brought to:

Seventh floor Receptionist
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Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER
John L. Young
Primary Patent Examiner

March 8, 2004